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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/065,757	05/24/1993	SHUNPEI YAMAZAKI	0756875	3615

31780 7590 03/29/2005

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EXAMINER

KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/065,757

Applicant(s)

YAMAZAKI, SHUNPEI

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005 and 11 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,8,10,11,18-20,22-26 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,8,10,11,18-20 and 22 is/are allowed.
- 6) ☒ Claim(s) 23-26 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/22/04, 1/5/05, 1/6/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's first submission after final filed on 5 January 2005 has been entered.

The LePage article and the Chemical abstract citation cited in the information disclosure statement filed 22 April 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The Office Action for Serial Number 07/859,254 has been considered. But has a line drawn through it since it is not prior art and thus should not appear on any patent resulting from this application.

Applicant resubmitted page 3 of the information disclosure statement of 22 April 2004 with the information disclosure statement of 5 January 2005. The duplicate citations have been line through.

The amendments to the claims have overcome the objection to claim 14 and the art rejections over claims 12 and 14. The 35 USC 112 rejection is withdrawn due to applicant's arguments and the translation of JP 62-72483. It appears the person who translated the specification and Kunitaka Yamamoto, who translated JP 62-72483, translated the same Japanese phrase two different ways. Thus the Examiner is interpreting the claimed phrase "along which a superconducting carrier flows" and the phrase "superconductivity results from electrons

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in the layer-like structure” on page 5 as being the same. Thus the claimed phrase does have support in the specification and is not new matter. Due to the amendments to claims 4 and 11 in 07/859,254, the obviousness double patenting rejection is withdrawn. Applicant's arguments with respect to the art rejections have been fully considered but they are not persuasive.

Claims 23-26 and 31-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Due to interpretation that the phrases “along which a superconducting carrier flows” and “superconductivity results from electrons in the layer-like structure” have the same meaning, claims 31-38 are duplicates of claims 23-26. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper to reject to the other as being a substantial duplicate of the allowed claim.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 23-26 and 31-34 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US Patent 6,638,894; U.S. patent 6,635,603; or U.S. Patent 6,630,425.

All three of these patents teach superconducting copper oxide ceramics having a perovskite structure and comprising atoms of copper oxygen, a rare earth element, preferably yttrium and an alkaline earth element, preferably barium. Figure 1, in all three patents, graphically demonstrates the structure of the taught superconductor. This figure shows the taught superconductors all have the same structure as that claimed. The examples in the table all teach superconducting copper oxides having the claimed structure and comprising atoms of copper

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oxygen, yttrium and barium which have a critical temperature being no lower than 70K. Thus the references teach superconducting copper oxide ceramics which are identical to those claimed. The only claimed aspect not taught by the references are that a superconducting carrier flows along the copper oxide layers, but one of ordinary skill in the art would expect the superconducting carrier to flow along the taught copper oxide layers since the taught superconducting ceramics are identical to those claimed.

Applicant argues the rejection is improper since the references do not teach how the electrons flow through the crystal structure and the Examiner must point out where the references teach the claimed invention. Figure 1 in all three patents show the claimed crystal structure and the explanation of this figure teaches the claimed composition, as does the formulas and the examples in the references. The fact the reference does not note of the claimed property does not mean the ceramic itself patentable. The claiming of an unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977) As long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999). Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

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Applicants state there is no disclosure of anisotropy in the references, but the claims do not require anisotropy. The rejection is maintained.

Claims 6, 8, 10, 11, 18-20 and 22 are allowable for the reasons given in the previous action.

Claims 23-26 and 31-34 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 and 15-22 of copending Application No. 07/859,254. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Applicant's comments with respect to the 35 USC 101 rejection are noted.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.129(a) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.129(a). Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the submission under 37 CFR 1.129(a). See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

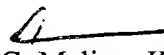
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
March 21, 2005


C. Melissa Koslow
Primary Examiner
Tech. Center 1700